

REMARKS/ARGUMENTS

Status

Claim 4 has been cancelled by the present amendment and no claim has been added. Claims 3, 5-16 and 18-20 will remain for further consideration. Typographical errors have been corrected in 18 and 19.

Claim History

The Examiner rejected claim 4 under 37 CFR 1.75 and claims 3-8, 19 (method 1), 9-10, 14, 15, 20 (method 2) and 16, 18 (method 3) under 35 U.S.C. § 103 over KAPLAN, in view of COSTIN, et al.

Claim Objections

35 U.S.C. § 103

The Examiner rejected claims 3-8, 19 (method 1), 9-10, 14, 15, 20 (method 2) and 16, 18 (method 3) under 35 U.S.C. § 103(a) as obvious over KAPLAN, in view of COSTIN, et al.

This rejection is respectfully traversed.

While both KAPLAN and COSTIN have charitable applications, neither system, taken individually or even in view of each other, mention or teach methods for the creation of the bounty through the selection of each of the constituent components of the bounty design process as explicitly stated in the present application.

The material significance of this distinction becomes more evident when one considers a hypothetical scenario involving a major problem such as HIV, tobacco addiction, or malaria. Under KAPLAN alone, someone trying to address one of these problems would be limited to setting up a charity (beneficiary) and availing themselves of the services of a KAPLAN online fundraising service provider. And, under COSTIN alone, one could use a pre-existing budget to segment the subcategories of the problem and reward parties who solve such subcategories. Even considering KAPLAN and COSTIN in view of each other, which we respectfully but strongly appeal to the Examiner not to do as later described, one might attempt to design, though it is even now not obvious how, an on-line system where third parties could register a problem to be solved for reward in such a way that the solver of a problem is the beneficiary of reward money that is aggregated online. One great limitation of this approach is that the bounty model supported, even when taking both KAPLAN and COSTIN in view of each other, is limited to a process model of a "classic bounty" that is, a model under which the beneficiary is necessarily the actor solving the problem and the conditions are the solution of the problem.

By contrast, the present application uniquely and purposefully hinges upon the deconstruction of the bounty design process, explicitly making variable all the process components. Accordingly, the present invention offers a unique opportunity to not only tap collective knowledge to solve problems like COSTIN or tap collectively finances to raise funds like KAPLAN but to also tap global collective creativity to create interesting bounties that may employ thousands of unique variable combinations of the bounty components including conditions, actors, benefactors, and beneficiaries.

The present invention uniquely and expressly provides the creative environment for the making and funding of unique bounty design. Returning to hypothetical scenarios, at this very moment there may be in all corners of the world people who are very creative, yet otherwise poor and un-empowered, but still capable of creating, through the present invention, unique bounties capable of focusing the world's attention and resources on problems such as the aforementioned HIV, tobacco addiction, or malaria. KAPLAN and COSTIN, taken in combination and with FIDLER, SCHWARTZ, and SWIMATHON, are not designed to nor do they provide this level of creative empowerment for building unique bounties with variable constituent elements as described.

Furthermore, we continue to respectfully submit that the combination of the references used to reject the current application is impermissible and inconsistent with legal precedent.

The invention must be considered as a whole without the benefit of hindsight, and the claims must be considered in their entirety. Rockwell International Corp. v. United States, 147 3 F.3d 1358, 1364 (Fed. Cir. 1998).

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 837 F.2d 1071, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988). It is impermissible to use the claimed invention as a blueprint from which to reconstruct the prior art to satisfy the claimed invention. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543, 548 (Fed. Cir. 1985) ("From its discussion of the prior art it appears to us that the court, guided by the defendants, treated each reference as teaching *one* or more of the

specific components for use in the Feil system, although the Feil system did not then exist. Thus the court reconstructed the Feil system, using the blueprint of the Feil claims. As is well established, this is legal error.")

The prior art must be considered as a whole and suggest the desirability and thus the obviousness of making the combination. Lindermann Maschinefabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)

There must be a suggestion or motivation in the prior art to modify a reference to satisfy the claimed invention. In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."
Id. (emphasis added)

"When an obviousness determination is based on multiple references, there must be a showing of some 'teaching, suggestion, or reason' to combine the references...Although a reference need not expressly teach that the disclosure contained therein should be combined with another the showing of combinability, in whatever form, must be 'clear and particular.'" Winner International Royalty Corp. v. Wang, 202 F.3d 1340, 1348-1349 (Fed. Cir.), cert. denied, 530 U.S. 1238 (2000)(emphasis added)

"The factual inquiry whether to combine references must be thorough and searching'...*It must be based on objective evidence of record.* This precedent has been reinforced in myriad decisions and cannot be dispensed with...The need for specificity pervades this authority...This factual question of motivation is material to patentability,

and could not be resolved on subjective belief and unknown authority...'*Common knowledge and common sense*,' even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority." In re Lee, 277 F.3d 1338, 1343-1345 (Fed. Cir. 2002)

"There is no suggestion to combine, however, if a reference teaches away from its combination with another source." Tech Air, Inc., 192 F.3d at 1360 (emphasis added). See also Winner International Royalty Corp., 202 F.3d at 1349-1350 ("Second, if Johnson did in fact teach away from Moore, then that finding alone can defeat Wang's obviousness claim.")

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference would be discouraged from following the path set *out* in the reference, *or* would be led in a direction divergent from the path taken by the applicant... [*or*] if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by applicant." In re Gurley, 27 F. 3d 551, 553, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994) and Tech Air, Inc. v. Denso Mfg. Michigan Inc., 192 F.3d 1353, 1360 (Fed. Cir. 1999).

There is no reason to combine Kaplan and Costin. Kaplan is to a method of providing a competition between potential parties to have a problem solved. There is no teaching of using the system as a means of raising capital, but conversely, as a means of solving a problem. In Kaplan, money is used to solve a problem. The problem is not used to raise money, though Kaplan does say that users are "encouraged" to donate money to charity. Additionally, in Kaplan, the actor (i.e., the person completing the condition) is the


benefactor, unlike the present invention. Costlin cannot be combined with Kaplan. There is no reason to combine them, as Kaplan is not a capital raising website, but merely a means for allowing people to compete for money which is already offered. Costin merely provides a method of sending out e-mails with links where a donor can donate money directly to a charity. There is no benefactor, no actor, no conditions, etc. There is no reason to combine, and even if the references were combined, the combination does not cure the deficiencies of either and does not provide an actor completing a condition so that a benefactor will release funds to a recipient other than the actor. Fidler and BT Swimathon merely show a game show and a swimathon where money is donated to a charity. Neither of these shows an on-line website for registering a bounty offering providing a beneficiary and viewers that contribute to a beneficiary when an actor (not the beneficiary) complete a condition. For at least these reasons, the claims of record should be allowed.

Summary

Applicant has made a diligent and bona fide effort to answer each and every ground for rejection or objection to the specification including the claims and to place the application in condition for final disposition. Reconsideration and further examination is respectfully requested, and for the foregoing reasons, Applicant respectfully submits that this application is in condition to be passed to issue and such action is earnestly solicited. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone the applicant, David Bain, at 703-587-9590 to satisfactorily conclude the prosecution of this application.

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Respectfully submitted,



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